

REMARKS

This Amendment is submitted in reply to the non-final Office Action mailed on March 23, 2007. No fee is due in connection with this Amendment. The Director is authorized to charge any additional fees which may be required, or to credit any overpayment to Deposit Account No. 02-1818. If such a withdrawal is made, please indicate the Attorney Docket No. 112703-306 on the account statement.

Claims 1, 4, 6-11, 14-16, 18-21 and 27-33 are pending in this application. Claims 2-3, 5, 12-13, 17 and 21-26 were previously canceled or withdrawn. In the Office Action, Claim 15 is objected to under 37 CFR 1.75(c). Claim 4 is rejected under 35 U.S.C. §112, second paragraph. Claims 1, 4, 6-11, 14-16, 18-20 and 27-33 are rejected under 35 U.S.C. §103. In response, Claim 15 has been canceled. Claims 4, 27 and 32-33 have been amended. In view of the amendments and/or for the reasons set forth below, Applicants respectfully submit that the rejections should be withdrawn.

In the Office Action, Claim 15 has been objected to under 37 CFR 1.75(c). In response, Applicants have canceled Claim 15 without prejudice or disclaimer.

Accordingly, Applicants respectfully request that the objection of Claim 15 under 37 CFR 1.75(c) be withdrawn.

In the Office Action, Claim 4 is rejected under 35 U.S.C. §112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Specifically, the Patent Office asserts that “the agent” in lines 1-2 of Claim 4 fails to specify if the “the agent” is the cooling agent or the heating agent. See, Office Action, page 2, lines 19-20. In response, Claim 4 has been amended to recite, in part, wherein the heating agent is present in an amount of from about 0.01% to about 2.0% by weight of the total consumable product. The amendment is supported in the specification at, for example, page 3, lines 9-10. In view of the amendment and/or for at least the reasons discussed above, Applicants respectfully submit that amended Claim 4 complies with 35 U.S.C. §112, second paragraph.

Accordingly, Applicants respectfully request that the rejection of Claim 4 under 35 U.S.C. §112, second paragraph be reconsidered and the rejection be withdrawn.

In the Office Action, Claims 27-33 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,372,824 to Record et al. (“Record”) in view of U.S. Plant

8,645 to Sturtz ("Sturtz"). In response, Applicants have amended Claims 27 and 32-33 to recite specific heating agents. In view of the amendments and/or for the reasons set forth below, Applicants respectfully submit that the rejections should be withdrawn.

Amended Claims 27 and 32-33 recite, in part, a heating agent chosen from the group consisting of capsicum oleoresin, capsaicin, piperine, gingerol, shoagol, cinnamic aldehyde, ginger oleoresin, cinnamon oleoresin, and cassia oleoresin, black pepper oleoresin, pepper oleoresin and combinations thereof. The amendment is supported in the specification, for example, at page 3, lines 3-13. In contrast, Applicants respectfully submit that there is no reason to combine certain cited references and, even if combinable, all of the claimed elements are not taught or suggested by the cited references. For example, *Record* and *Sturtz* fail to disclose or suggest a heating agent chosen from the group consisting of: capsicum oleoresin, capsaicin, piperine, gingerol, shoagol, cinnamic aldehyde, ginger oleoresin, cinnamon oleoresin, and cassia oleoresin, black pepper oleoresin, pepper oleoresin and combinations thereof as required, in part, by Claims 27 and 32-33.

Accordingly, Applicants respectfully request that the obviousness rejections with respect to Claims 27-33 be reconsidered and the rejections be withdrawn.

In the Office Action, Claims 1, 4, 6-10, 27-31 and 33 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 4,645,662 to Nakashima et al. ("Nakashima") in view of *Sturtz*. For at least the reasons set forth below, Applicants respectfully submit that the rejections be withdrawn.

Applicants respectfully submit that not only does there not exist any reason to combine *Nakashima* and *Sturtz* to arrive at the present claims, the references teach away from same. For example, Applicants respectfully submit that references must be considered as a whole and those portions teaching against or away from the claimed invention must be considered. *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve Inc.*, 796 F.2d 443 (Fed. Cir. 1986). "A prior art reference may be considered to teach away when a person of ordinary skill, upon reading the reference would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the Applicant." *Monarch Knitting Machinery Corp. v. Fukuhara Industrial Trading Co., Ltd.*, 139 F.3d 1009 (Fed. Cir. 1998) (quoting *In re Gurley*, 27 F.3d 551 (Fed. Cir. 1994)).

In its attempt to arrive at the present claims by combining the cited references, the Patent Office has ignored significant portions of each reference that teach away from the combination and/or the present disclosure. For example, *Nakashima* is directed toward an oral composition for preventing and remedying dentinal hypersensitivity. See, *Nakashima*, Abstract. To effectively reduce sensitivity a soluble aluminum compound is used for constriction or occlusion of tubular orifices. However, the soluble aluminum compound causes a metallic and astringent taste to be incorporated into the oral composition. To reduce this metallic and astringent taste, *Nakashima* explicitly teaches incorporating the oral composition with l-menthol as a flavor agent. See, *Nakashima*, col. 8, lines 11-14. Moreover, *Nakashima* teaches away from *Sturtz* by encouraging incorporation of l-menthol as a flavor where the amount of 1-menthol can be as much as 10% by weight. See, *Nakashima*, column 8, lines 30-35. In contrast, *Sturtz* is directed to a low menthol mint plant for producing an oil wherein menthol is substantially absent from the oil. See, *Sturtz*, col. 2, lines 29-32. Because *Nakashima* teaches significant amounts of l-menthol and *Sturtz* teaches a low menthol content, the references teach away from each other and the combination.

Moreover, while the Patent Office acknowledges that *Nakashima* encourages menthol as a flavor, the Patent Office also recognizes menthol as a cooling agent. See, Office Action, page 4, lines 3-4. In contrast, however, the present disclosure specifically states that “[c]ooling agents, for the purpose of the present invention, are defined as non-menthol cooling agents.” See, Specification, Summary of the Invention (emphasis added). Therefore, not only does *Nakashima* teach away from *Sturtz*, but *Nakashima* also teaches away from the presently claimed subject matter.

Applicants respectfully submit that the Patent Office has improperly applied hindsight reasoning by attempting to selectively piece together teachings of each of the references in an attempt to recreate what the claimed invention discloses. The fact that the prior art *may* be modified in the manner suggested by the Patent Office does not make the modification obvious. As a result, the skilled artisan would have no reason to combine the cited references to arrive at the present claims.

Nevertheless, Applicants also respectfully submit that, even if combinable, *Nakashima* and *Sturtz* do not disclose or suggest all of the elements of the present Claims. For example, *Nakashima* and *Sturtz* fail to disclose or suggest heating agent chosen from the group consisting

of capscicum oleoresin, capsaicin, piperine, gingerol, shoagol, cinnamic aldehyde, ginger oleoresin, cinnamon oleoresin, and cassia oleoresin, black pepper oleoresin, pepper oleoresin and combinations thereof as required, in part, by Claims 1, 11, 27 and 32-33.

For at least the reasons discussed above, the combination of *Nakashima* in view of *Sturtz* is improper or fails to disclose or suggest every element of the present claims and thus fails to render the claimed subject matter obvious.

Accordingly, Applicants respectfully request that the obviousness rejections with respect to Claims 1, 4, 6-10, 27-31 and 33 be reconsidered and the rejections be withdrawn.

In the Office Action, Claims 1, 4, 6-11, 14-16, 18-20, and 27-33 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,015,464 to Strobridge ("Strobridge") in view of *Sturtz*. For at least the reasons set forth below, Applicants respectfully submit that the rejection be withdrawn.

Applicants respectfully submit that the skilled artisan would have no reason to combine *Strobridge* and *Sturtz* to arrive at the present claims. Specifically, Applicants respectfully submit that references must be considered as a whole and those portions teaching against or away from the claimed invention must be considered. For example, *Strobridge* is directed toward anti-plaque chewing gums comprising anti-plaque properties. See, *Strobridge*, Abstract. Specifically, the gum must comprise an anti-plaque effective amount of eucalyptol, menthol, methyl salicylate and thymol. Too little of the essential oils will render the product ineffective against plaque. See, *Strobridge*, col. 2, lines 38-52. In contrast, however, *Sturtz* is directed to a low menthol mint plant for producing an oil wherein menthol is substantially absent from the oil. See, *Sturtz*, col. 2, lines 29-32.

Moreover, in the Office Action, the Patent Office notes that menthol is considered a cooling agent. See, Office Action, page 4, line, 22. However, as discussed above, the present disclosure specifically states that "[c]ooling agents, for the purpose of the present invention, are defined as non-menthol cooling agents." See, Specification, Summary of the Invention (emphasis added). Therefore, not only does *Strobridge* teach away from *Sturtz*, but *Strobridge* also teaches away from the presently claimed subject matter.

Applicants respectfully submit that the Patent Office has improperly applied hindsight reasoning by attempting to selectively piece together teachings of each of the references in an attempt to recreate what the claimed invention discloses. The fact that the prior art *may be*

modified in the manner suggested by the Patent Office does not make the modification obvious. As a result, the skilled artisan would have no reason to combine the cited references to arrive at the present claims.

For at least the reasons discussed above, the combination of *Strobridge* in view of *Sturtz* is improper or fails to disclose or suggest every element of the present claims and thus fails to render the claimed subject matter obvious.

Accordingly, Applicants respectfully request that the obviousness rejections with respect to Claims 1, 4, 6-10, 14-16, 18-20 and 27- 33 be reconsidered and the rejections be withdrawn.

In the Office Action, Claims 1, 4, 6-9, 11, 14-16, 18-19, 27-30 and 32-33 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Publication No. 2002/0119231 to Kumamoto et al. ("Kumamoto") in view of *Sturtz*. For at least the reasons set forth below, Applicants respectfully submit that the rejections be withdrawn.

Applicants respectfully submit that the skilled artisan would have no reason to combine *Kumamoto* and *Sturtz* to arrive at the present claims. Specifically, Applicants respectfully submit that references must be considered as a whole and those portions teaching against or away from the claimed invention must be considered. For example, *Kumamoto* is entirely directed toward warming compositions that are incorporated into consumable products. See, *Kumamoto*, Abstract. In the Background of the Invention, *Kumamoto* repeatedly emphasizes that the invention is directed toward providing warming compositions that exhibit long-lasting warming effects.

In contrast, however, *Sturtz* is directed primarily toward a new and distinct variety of a mint plant, now known as erospicata. See, *Sturtz*, Abstract. Erospicata can be used as a replacement to various cooling agents, including peppermint, to create a cooling composition without epithelial irritation caused by large amounts of menthol. Therefore, in contrast to *Kumamoto*, *Sturtz* is entirely directed toward providing cooling compositions. As such, the warming compositions disclosed by *Kumamoto* teach away from a combination with the cooling compositions of *Sturtz*, and the skilled artisan would have no reason to combine the cited references to arrive at the present claims.

Moreover, in contrast to the desired warming compositions of *Kumamoto*, the present disclosure states that a heating agent may be used to potentiate the cooling agent to create an enhanced cooling flavor in an oral product also containing erospicata. See, Specification,

Summary of the Invention. Thus, the goal of producing warming compositions in *Kumamoto* teaches away from the present disclosure. Therefore, not only does *Strobridge* teach away from *Sturtz*, but *Strobridge* also teaches away from the presently claimed subject matter.

Applicants respectfully submit that the Patent Office has improperly applied hindsight reasoning by attempting to selectively piece together teachings of each of the references in an attempt to recreate what the claimed invention discloses. The fact that the prior art *may* be modified in the manner suggested by the Patent Office does not make the modification obvious. As a result, the skilled artisan would have no reason to combine the cited references to arrive at the present claims.

Accordingly, Applicants respectfully request that the obviousness rejections with respect to Claims 1, 4, 6-9, 11, 14-16, 18-19, 27-30 and 32-33 be reconsidered and the rejections be withdrawn.

For the foregoing reasons, Applicants respectfully request reconsideration of the above-identified patent application and earnestly solicit an early allowance of same.

Respectfully submitted,

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